REMARKS

Applicant submits this Amendment in response to the Office Action mailed January 31, 2001. Applicant respectfully submits that the Application as amended is in condition for allowance and respectfully requests an early indication of allowance.

I. BRIEF DISCUSSION OF AMENDMENTS

The Examiner will note that the specification has been amended to correct a typographical error (the printer is attached to the primary computer, not the secondary computer).

The Examiner will also note that independent claims 1 and 9 have been amended and new independent claims 19 and 20 added. No new matter has been added. In addition, dependent claims 2, 3, 12 and 13 have been canceled without prejudice in view of the amendments to claims 1 and 9. As discussed below, Applicant believes that all remaining original claims, as amended hereby, as well as new claims 19 and 20, are allowable over the art of record.

II. CLAIMS REJECTIONS

The Examiner rejected original claims 1 and 2 under 35 U.S.C. § 102(b) as allegedly being anticipated by Siegel, U.S. Patent No. 4,732,411. The Examiner also rejected original claims 3-18 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Siegel, U.S. Patent No. 4,732,411, in view of Williamson, U.S. Patent No. 5,842,976. Applicant respectfully submits that all remaining original claims, as amended hereby, as well as new independent

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claims 19 and 20, are patentably distinct from and allowable over Siegel, Williamson and the other art of record.

As the Examiner will note, independent claims 1 and 9 have been amended to indicate that the computer software object representing the patient photograph is created on a first computer (or equivalent) and the label combining the photograph with the prescription information is created on a second computer (or equivalent). It is respectfully submitted that claims 1 and 9 as amended are patentable over Siegel and Williamson.

With respect to Siegel, the Examiner admits that this reference fails to teach the two-computer combination of the present invention. (Office Action, at 3.)

With respect to Williamson, that reference relates to a system for monitoring and dispensing medication to patients through the use of a central "site computer" and mobile "charting computers". There is no teaching or suggestion in Williamson that the system may be used to create prescription labels, as in the present invention, nor is there any teaching or suggestion in Williamson to combine Williamson with Siegel in the manner suggested by the Examiner. See Ex parte Levengood, 28 U.S.P.Q.2d 1300, 1302 (Bd. Pt. App. & Inter. 1993) (obviousness cannot be established by combining references "without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done"). Applicant respectfully submits that the Examiner's statement that it would have been obvious to one of ordinary skill in the art to modify Siegel in view of Williamson so as to use two computers does not satisfy the evidentiary standard of Ex parte Levengood.

Moreover, Williamson teaches away from the present invention. In Williamson, the "site computer" distributes patient photographs to the nurse's mobile "charting computers" so that the nurses can view the photographs on a monitor and thereby verify patient identity. Thus,

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Williamson teaches that a mobile computer, and not a printed label as in the present invention, should be used for patient identification. One of ordinary skill in the art would thus modify Siegel in view of Williamson to eliminate the use of a printed label, contrary to the present invention.

Additionally, in Williamson the "site computer" is a central repository of data, including photographs, and distributes the photographs to the mobile "charting computers" which are used for patient identification. In the present invention, on the other hand, the primary computer (which is arguably analogous to Williamson's "site computer") does not distribute data to the secondary computer (which is arguably analogous to Williamson's "charting computers"). Assuming, arguendo, that one of ordinary skill in the art would combine Williamson and Siegel in the manner suggested by the Examiner, Williamson would teach that the "charting computers" be used to create and print the labels, and not the "site computer." This is directly opposite to the present invention, where the primary computer, not the secondary computer, is used to create and print the labels.

Accordingly, it is respectfully submitted that amended claims 1 and 9, as well as all of the remaining original claims which depend therefrom, are allowable over Siegel and Williamson, as well as the other art of record.
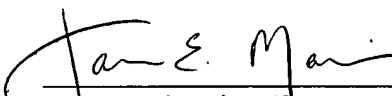
It is also believed that new independent claims 19 and 20, which have been added to give Applicant a broader scope of protection for the present invention, are allowable over the cited art as well.

The Commissioner is hereby authorized to charge any fees required by this amendment, including any fee required for the addition of one new independent claim, or credit any overpayment, to Account No. 501-814, Order No. 42543.3.

In view of the foregoing, Applicant respectfully submits that the Application is in condition for allowance and respectfully requests an early indication of allowance.

Dated: July 31, 2001

Respectfully submitted,

James E. Marina, Esq.
Reg. No. 41,969

APPENDIX 1

Referring to figure 1, the system 10 in accordance with the present invention includes a

digital camera 12 for taking digital photographs of the patients, such as a Kodak™ digital

camera; a secondary computer 14, such as an IBM compatible personal computer, for

downloading the digital photographs from the digital camera 12 and converting the photographs

into software objects; a primary computer 16, such as a midrange computer, for creating the

labels; and a printer 18 attached to the [secondary] primary computer 16 for printing the labels.

APPENDIX 2

1. (Amended) A method of labeling a container of prescribed medicine, said method comprising the steps:

  obtaining a photograph of a patient;

  converting said photograph into a computer software object <u>on a first computer</u>;

  creating <u>on a second computer</u> a label containing prescription information of said patient and said photograph by combining said computer software object with said prescription information;

  printing said label; and

  attaching said label to said container.

APPENDIX 3

9. (Amended) A system for labeling a container of prescribed medicine, said system comprising:

a camera for taking a photograph of a patient;

means for converting said photograph into a computer software object;

means, <u>distinct from said means for converting</u>, for creating a label containing prescription information of said patient and said photograph by combining said computer software object with said prescription information; and

a printer for printing said label.